



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,473	03/11/2004	Michael Jason Ullom	9550	7417

27752 7590 06/07/2011
THE PROCTER & GAMBLE COMPANY
Global Legal Department - IP
Sycamore Building - 4th Floor
299 East Sixth Street
CINCINNATI, OH 45202

EXAMINER

FUBARA, BLESSING M

ART UNIT	PAPER NUMBER
----------	--------------

1613

MAIL DATE	DELIVERY MODE
-----------	---------------

06/07/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/798,473	Applicant(s) ULLOM ET AL.
	Examiner BLESSING FUBARA	Art Unit 1613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 and 20-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date <u>6/14/2004; 7/18/2005</u>.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
|--|---|

DETAILED ACTION

1. The examiner acknowledges receipt of Response to restriction requirement and remarks filed 03/28/2011. The examiner also acknowledges receipt of IDS filed 6/14/2004 and 7/18/2005. Claims 1-26 are pending.

Election/Restrictions

2. Applicant's election with traverse of Group II, claims 8-19 in the reply filed on 3/28/3011 is acknowledged. The traversal is on the ground(s) that at least Groups II and III, belonging to the same class/subclass can be examined together without undue burden on the examiner, that the examiner's reasons for finding the restriction proper is no reason at all and those reasons are not supported by the MPEP 808.02 and that the restriction requirement should be withdrawn without sufficient showing as to search and examination burden. This is not found persuasive because A) applicant has not clearly submitted evidence on the record that the receptacle of claim 8 is an obvious variant of the kit containing a topical composition in a sachet and a receptacle of claim 20 (see paragraph 20 of the office action of 03/01/2011) such that a rejection that the kit containing the receptacle and the sachet of topical composition is an obvious variant of the receptacle should have been made; B) the receptacle of claim 8 does not contain the sachet while the kit contains the sachet that contains a unit dose of the topical composition and receptacle; C) therefore, applicant is requiring the examiner to further search for a kit containing the receptacle and the sachet of topical composition, after the search for the receptacle; D) such a search is burdensome. The examiner has carefully reconsidered the arguments and applicants un-acceptance of the reasons advanced for requiring the restriction, however, the art teaching the receptacle does not have a composition in the receptacle to have necessitated rejoining the kit

Art Unit: 1613

containing the receptacle plus composition group of claims with the receptacle group of claims--- this meets the criteria given in the office action of 03/01/2011 that different searches may be required for the different claim groups. The examiner also reconsidered the requirement that activation of the heating system by insertion of said sachet is different from activation by a switch and finds the requirement proper because clicking a switch to turn on a device is different from activating that switch by inserting an object into the device. However, because activating the switch by an alien object and activating the switch by clicking the switch is an obvious variant of activating the switch, the election requirement between claims 12 and 13 is withdrawn.

The requirement is still deemed proper and is therefore made FINAL.

Priority

3. The examiner acknowledges this application as claiming benefit of 60/516,502 filed 10/31/2003 and 60/516,523 filed 10/31/2003. It is suggested that page 1 of the instant specification be amended to include the priority information in the line above the “**Field of the Invention**” on page 1.

4.

5. **Claims 1-7 and 20-26 Stand Withdrawn With Traverse:**

6. Claims 1-7 and 20-26 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 03/28/2011.

Art Unit: 1613

7. Claim 8 is directed to a receptacle. The function of the receptacle is to warn a sachet containing topical composition. The receptacle of claim 8 does not contain the sachet.

Therefore, examination is to the receptacle.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 8-11 and 13-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Boudreaux (US 5,856,653).

10. Boudreaux discloses a container that is designed to accept mascara bottle or container for warming; the container has elements i) ii) and iii) of claim 8 (see the whole document with emphasis on column 1, line 35 to column 3, line 39 and claims 1-9). Claims 13 and 14 recite the characteristic of the device.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

Art Unit: 1613

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boudreaux (US 5,856,653) in view of Paul (4,733,054).

14. Boudreaux anticipates the receptacle of claim 8 (see Figs. 1-3, column 1, lines 36 to column 3, line 36 and claims 1-9). While the container/receptacle is switched on by clicking the on and off switch 4, Boudreaux does not use the electric on/off switch that automatically activates when an object is placed on it. However electrical components whose on and off switches respond to motions or contacts with objects are known. For example, a hot food stand heat lamps automatically activate when food is placed on pressure sensitive support (see the abstract of Paul). The advantage is that the device automatically turns on when an object is placed over it and turns off when the object is removed (column 1, line 42).

15. Therefore, one having ordinary skill in the art at the time the invention was made would desire to have a sensor such as the one in the hot food stand such that the container device of Boudreaux automatically turns on when the mascara container is placed in the receptacle and automatically turns off when the mascara container is removed.

16. No claim is allowed.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BLESSING FUBARA whose telephone number is (571)272-0594. The examiner can normally be reached on Monday to Thursday from 7 a.m. to 5:30 p.m.

Art Unit: 1613

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Y. Kwon can be reached on (571) 272-0581. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Blessing M. Fubara/
Primary Examiner, Art Unit 1613